



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,592	01/14/2002	R. Michael Gross		3738

7590

04/19/2005

Dennis L. Thomte  
THOMTE, MAZOUR & NIEBERGALL, L.L.C.  
Suite 1111  
2120 South 72nd Street  
Omaha, NE 68124

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/046,592

Applicant(s)

GROSS, R. MICHAEL

Examiner

Brian E Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 10 January 2005 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kater (5046509). Fig. 1 shows a tool having an elongated tube **100** with an outer surface and a proximal end that may be placed in communication with a suction mechanism. It can also be seen there is a sleeve **112** that is slidably coupled to the outer surface of the elongated tube. Additionally, Kater discloses a gasket **108** operatively coupled at the distal end of the sleeve and positioned to provide a seal between the tube and the sleeve. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of being inserted through the coracoid process and the gasket being shaped and sized for selective sealing engagement with the coracoid process. It can also be seen the distal end of the tube can be considered to be angularly disposed since the tip has an angle cut.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Kramer et al. (4969870). Fig. 2 shows a tool having an elongated tube **15** with an outer surface and a proximal end that may be placed in communication with a suction mechanism. It can also be seen there is a sleeve **19** that is slidably coupled to the outer surface of the elongated tube. Additionally, Kramer discloses a sealing surface **21** at the distal end of the sleeve that *can be* positioned against bone around an opening to seal a bone cavity.

Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of drawing material into a body cavity by forming a negative pressure and suction.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kater '509 in view of Lee et al. (5693030). Kater is explained supra. However, Kater fails to disclose openings in the tip of the tube and an obturator. Lee et al. teach (Fig. 1) a tube with a distal portion having a plurality of openings **32** therein for greater communication with the channel in the tube. Lee also teaches (Fig. 3) an obturator **60** that may be extended in the tube that is fully capable of clearing debris. It would have been obvious to one of ordinary skill in the art to use a plurality of openings in the end of the tube and an obturator as taught by Lee et al. with the tool of Kater such that greater suction or pressure can be created with more openings and the obturator provides the ability of the surgeon to free up any debris accumulation that would block the flow of material being removed.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kater '509 in view of Dubinsky (WO 99/52441). Kater is explained supra. However, Kater fails to disclose the end of the tube having an arcuate portion. Dubinsky teaches (Fig. 1) an elongated tube **125** having an arcuate portion that enables the device to be placed

Art Unit: 3738

within a curved cavity. It would have been obvious to one of ordinary skill in the art to use an arcuate portion as taught by Dubinsky with the tool of Kater such that the surgeon has more maneuverability with the tool and less likely to damage tissue when approaching a cavity that is not in the direct path of the tool.

### ***Response to Arguments***

Applicant's arguments filed 1/10/05 have been fully considered but they are not persuasive. The examiner is interpreting the claimed elements "sleeve that is slidably coupled" in this way: since the tube and gasket and sleeve are all separate elements, the gasket must inherently be "slidably mounted" along with the sleeve on the tube. Also, according to Microsoft Bookshelf Dictionary the definition of *coupled* is: two things connected together. Thus, "attached" can be considered synonymous as connected together. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054, 1055. Regarding the amendment to claim 4, the Examiner is interpreting the limitations as claimed "the distal end" to mean something having an angle, which the Kater tool clearly does. In response to applicant's argument that the amended claim 8 is used differently than the prior art, a recitation of the intended use of the claimed invention must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable of* performing the intended use, then it meets the claim. In a claim drawn to a process of making, the

Art Unit: 3738

intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Applicant has not pointed out any *structural difference* between the claimed invention or the prior art, but states the prior art is capable of "gripping the surface" which according to the Examiner can be interpreted to be is capable of "sealing a surface".

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 6:30am to 4pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

**BRIAN E. PELLEGRINO**  
**PRIMARY EXAMINER**

A handwritten signature in black ink that reads "Brian E. Pellegrino". The signature is written in a cursive, flowing style.